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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,286	06/22/2001	Ronald A. Katz	6646-101D7	9210

7590

03/17/2005

Attention: Reena Kuyper  
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EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/888,286

Applicant(s)

KATZ, RONALD A.

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/08/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 24-26, 28-33, 35, 36, 38-41, 43 and 45-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barr et al. ('530) in view of Roberts et al. ('553).

Barr et al. disclose the claimed invention including a product (10- ticket) for use with a telephone-interface system accessed through a telephone communication facility; the ticket being a base substrate having telephone number data indicative of a toll free number ("800-999-1000", "800-886-5000", "800-123-9000" - see figs. 1a, 1b, 2 and 3) which is to be entered by a caller via a telephone; the indicia (20) being unique identification data ("The number in the game area 20 may be different from the other number in other cards", see col. 2, lines 60-62; therefore, game area provides unique identification data); the substrate having additional data (30) printed thereon; obscuring means (22, 32) for obscuring the indicia; the obscuring means being provided over at least a portion of the unique identification data (as seen in figure 1); and the substrate further including another unconcealed indicia related to the telephone processing format ("INSTRUCTIONS", as seen in figures 1, 1a, 1b, 2 and 3, is related to the telephone processing format, since the instructions are directed to the use of the ticket in the telephone-interface system).

Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Barr et al. disclose the claimed invention except for the indicia including a visual symbolic graphic representation and the additional data including a machine-readable code.

Roberts et al. disclose lottery tickets having visual symbolic graphic representation (14) that is also represented in machine-readable format (16). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Barr's invention to include graphic and machine readable indicia, as taught by Roberts et al., to provide indicia that is both aesthetically pleasing to the eye and provides tamper-proof capabilities for ensuring proper use of the lottery tickets.

As to the indicia on the substrate serving as a consumable key (claims 24 and 29) or telephone number data relating to called terminal digital data (claims 30 and 31) or the unique identification data being tested by a telephonic-interface control system to provide an indication of that limits (one time only use – claims 38 and 46; up to an

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extent of a limited dollar value – claims 40 and 48; during a defined interval of time – claims 45 and 47) specified on the use of the products that have been satisfied before allowing the callers to gain access to the at least certain operations of the specific telephone processing format (claims 32 and 41), the Examiner finds no new and unobvious functional relationship between the printed matter and the substrate upon which it is placed. That is, the relationship of the printed matter and the substrate merely set forth one of support and display. Accordingly, the content of the printed matter called for does not patentably distinguish over the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983) and *In re Miller*, 418 F. 2d 1392, 164 USPQ 46 (CCPA 1969).

Regarding claims 32, 33, 35, 36 and 38-40, see the above rejections. Further, Barr et al., as modified by Roberts et al., disclose providing a plurality of products for use with a telephone-interface system accessed through a telephone communication facility (see col. 1, lines 14-17 – "...a game comprising one or more tickets...").

3. Claims 27, 34, 37, 42 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barr et al. in view of Roberts et al. and further in view of Goldman et al. ('708).

Barr et al., as modified by Roberts et al., disclose the claimed invention except for the substrate having a value assigned to the product.

Goldman et al. disclose lottery tickets having a value assigned (12 - \$1) to the ticket. Therefore, it would have been obvious to one having ordinary skill in the art at the

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time of the invention to modify Barr's invention to include a value assigned thereto, as taught by Goldman et al., to visually provide the customer with an indication of price for the lottery tickets such that the customer would not have to rely on the seller to provide pricing information.

### ***Response to Arguments***

4. Applicant's arguments filed February 28, 2005 have been fully considered but they are not persuasive.

Applicant continues to argue the use of *In re Gulack*, 217 USPQ 401, (CAFC 1983) with respect to the presently claimed invention. Applicant states that the Gulack case did not involve data to be processed by a machine. Rather, it involved a substrate whose indicia were useful only to the human mind. The applicant further argues that in the present case, the data are for processing by a telephone-interface control system so the relationship of the data to the control system must be considered. The examiner continues to maintain that presently claimed invention sets forth a card product having indicia. The purpose or intent of the card does not set forth any structural limitations with respect to the card itself. The card merely supports printed matter where the printed matter does not convey any meaningful relationship in regard to the substrate and does not require any particular substrate to effectively convey the information. Thus, there is no meaningful functional relationship between the indicia and the substrate.

The examiner asserts that the card of Barr, as modified by Roberts, comprising telephone number data, unique identification data, an obscuring means for at least a portion of the unique identification data and other unconcealed data is the same structure claimed by applicant.

The limitation of the telephone number data being entered by a caller via telephone to gain access to at least certain operations of the specific telephone processing format of the telephonic-interface control system sets forth the intended use of the base substrate. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

For the reasons as set forth above, the rejections are maintained.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (571) 272-4475. The examiner can normally be reached on Monday-Thursday (6:00 AM - 3:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 15, 2005

*Monica S. Carter*  
**MONICA S. CARTER**  
**PRIMARY EXAMINER**